

REMARKS

In the Office Action the Examiner noted that claims 1-17 are pending in the application. The Examiner noted that claims 14-16 have been withdrawn from consideration, and rejected claims 1-13 and 17. By this Amendment, claims 1, 3, 12-13, and 17 have been amended. No new matter has been presented. Thus, claims 1-17 remain pending in the application. The Examiner's rejections are traversed below, and reconsideration of all rejected claims is respectfully requested.

Examiner Did Not Acknowledge Traversals of June 7, 2007

The Applicants respectfully submit that the Examiner did not acknowledge or address many of the traversals presented in the Amendment filed on June 7, 2007. To wit, the Examiner alleged in the Response to Arguments, on pages 8-9 of the Office Action, that the recited purchase information of the present claims is analogous to monetary value discussed in legal settlements. While the Applicants do not agree with this allegation by the Examiner, the Applicants also point out that several other traversals were made in the Amendment. For example, as only the complainant and subject are contemplated in Sloo, a commercial transaction between a plurality of providers is obviously not contemplated, much less disclosed or suggested. Therefore, it logically follows that there is also no selection of certain providers among a plurality of providers according to priority conditions. Various other arguments were presented in regard to the other cited references, and these arguments were not addressed by the Examiner.

Therefore, the Applicants respectfully submit that the Examiner has improperly made this action final. As noted in at least MPEP 707.07(f), the Examiner is required to answer and address all traversals. This requirement is in addition to any repetition of a previously held position and is required to allow the Applicants a chance to review the Examiner's position as to these arguments and to clarify the record for appeal. The Applicants respectfully submit that the response by the Examiner does not address the traversals made.

Additionally, and as further noted in MPEP 707.07(f), a failure of the Examiner to address the Applicants' traversals can be deemed a failure to rebut these arguments so as to admit that the arguments have overcome the rejection. At the very least, the failure to address the Applicants' traversals would render the Examiner's decision to again reject the claims arbitrary

and capricious and invalid under the Administrative Procedures Act, 5 U.S.C. § 706, the standard under which such rejections are reviewed in view of Dickinson v. Zurko, 527 U.S. 150, 50 USPQ2d 1930 (1999).

Claim Rejections Under 35 USC §103

On pages 3- 8 of the Office Action the Examiner rejected claims 1-13, and 17 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,895,450, issued to Sloo (hereinafter referred to as "Sloo") in view of U.S. Patent No. 6,330,551, issued to Burchetta et al. (hereinafter referred to as "Burchetta") and further in view of U.S. Patent No. 6,236,980, issued to Reese (hereinafter referred to as "Reese"). The Applicants respectfully traverse the Examiner's rejections of the remaining claims.

Claim 1 of the present application, as amended, recites a mediation negotiating method for mediating a negotiation between a client for an auction and providers of goods and/or services for the auction, including receiving response information in accordance with priorities from a plurality of providers, and wherein the providers are not identified to the client until the client issues a negotiation finalizing instruction. Support for the amendments to claim 1 may be found at least in the specification on Line 8, Page 22 through Line 2, Page 23. The Applicants respectfully submit that none of the references, taken together or alone, disclose or suggest at least the features of claim 1.

Sloo discloses a program which presents a draft solution from a claimant against another party in a legal claim. The program facilitates a negotiation processing in which, in a legal dispute, the program directs an apparatus to receive a complaint from a complainant against a subject, to receive from the subject a response to the complaint, and to store the complaint and response in a data record, along with negotiating a settlement of the complaint. Therefore, there are no client and providers of goods and/or services involved, and certainly no clients and providers of goods and services for an auction. In fact, there are apparently only two parties involved in the process disclosed in Sloo, i.e., the complainant and the subject. Thus, a commercial transaction between a client and a plurality of providers is not even contemplated, much less disclosed or suggested. Therefore, there is also no selection of certain providers among a plurality of providers according to priority conditions.

Further, since the parties in Sloo are parties to a particularly specified complaint, the party characterized as a "provider" by the Examiner is registered in the negotiation field and obviously known to the other party (characterized by the Examiner as the "client"). This is in

direct contrast to claim 1, wherein the providers are not identified until the client issues a negotiation finalizing instruction.

Burchetta does not cure the deficiencies of Sloo in regard to the discussed features of claim 1 of the present application. Burchetta discloses a negotiation processing based on priorities in which, when a negotiation does not become valid because a first demand and offer does not satisfy the first criterion, a second demand and offer are compared to see whether or not the second criteria are satisfied. As in Sloo, Burchetta discloses a computerized system for automated dispute resolution through the internet for communicating and processing a series of demands to satisfy a claim made by or on behalf of a claimant or other person involved in a dispute with at least one other person, such as a defendant or defendant's insurer. Therefore, even if one were to consider Burchetta to be in any way related to clients and providers in an auction, which it is not, the parties are known to each other before the process even begins, unlike the recited features of claim 1.

Reese also does not cure any of the deficiencies of Sloo or Burchetta in regard to claim 1 of the present application. Reese discloses a sequential display of abstracts of magazine articles in accordance with a ranking of the recommenders. However, this ranking is prepared merely on the recommendations of the recommending parties, and there is no disclosure or even contemplation of allocating priorities regarding requesting conditions from a client, selecting providers based on those priorities, or not identifying providers until a client issues a negotiation finalizing instruction. Again, as with Sloo and Burchetta, there is apparently no client/provider interaction disclosed or contemplated in Reese.

Further, even assuming *arguendo* that Sloo, Burchetta, and Reese did disclose the features discussed by the Examiner, the Applicants respectfully submit that there is no motivation to combine at least Reese with the other references. Reese discloses ranking magazine articles, which has nothing to do with the dispute resolution of Sloo and Burchetta (which in turn has nothing to do with the auction negotiation of claim 1 of the present application). The Examiner alleged that the motivation would be obvious in order to improve the percentage of negotiations that are settled, but the Applicants fail to recognize how the disclosure of Reese would provide any aid at whatsoever to Sloo, as the ranking of magazine articles is not related to notifying a party in a lawsuit of a settlement offer. In fact, the Examiner seems to be alleging that it would be obvious to rank a plurality of potential lawsuit parties, and then pick one with the highest settlement potential. However, the Applicants respectfully submit that this is not valid for a number of reasons, especially since the party to the suit is known, and there is no

reason for any such ranking. Also, the Applicants respectfully submit that the combination of the references cannot be valid simply because the fields of endeavor (dispute resolution and ranking magazine articles) are not related.

MPEP §2143.01 states that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so. Therefore, as there is no requisite motivation to combine the references cited by the Examiner, the Applicants respectfully request the withdrawal of the Examiner's §103 rejections. Even in the relatively and allegedly relaxed standards of obviousness after the KSR decision, there must still be a valid justification for such a combination.

In order to form a proper §103 rejection, the cited references must disclose all of the features of the rejected claim. As discussed above, none of the cited references, either alone or in combination, disclose or suggest the recited features of claim 1 of the present application. In fact, none of the recited features of claim 1 are even contemplated by the cited references, as they do not contemplate any sort of client/provider interaction regarding purchase information. Therefore, the Applicants respectfully submit that claim 1 patentably distinguishes over the cited references, and further respectfully requests the withdrawal of the Examiner's §103 rejection of claim 1.

Claims 2, and 4-11 depend from claim 1 and include all of the features of that claim plus additional features which are not disclosed by Sloo, Burchetta, and Reese. Therefore, it is respectfully submitted that claims 2, and 4-11 also patentably distinguish over Sloo, Burchetta, and Reese.

Independent claims 3, 12-13, and 17 recite similar features to those discussed in regard to claim 1, and which are not disclosed or suggested in the cited references. Therefore, it is respectfully submitted that claims 3, 12-13, and 17 also patentably distinguish over the cited references.

Summary

In accordance with the foregoing, claims 1, 3, 12-13, and 17 have been amended. No new matter has been presented. Thus, claims 1-17 remain pending, with claims 1-13 and 17 under consideration.

There being no further outstanding objections or rejections, it is respectfully submitted

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that the application is in condition for allowance. An early action to that effect is courteously solicited.

Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

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